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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,137

02/08/2006

Ralf Henn

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EXAMINER

ROJAS, BERNARD

ART UNIT

PAPER NUMBER

2832

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,137	<b>Applicant(s)</b> HENN ET AL.	
	<b>Examiner</b> BERNARD ROJAS	<b>Art Unit</b> 2832	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02082006</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement filed 02/08/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shouji et al. [US 5,796,564].

Claim 12, Shouji et al. discloses a carrier device for magnetizable substrates (Figure 1), comprising: at least one magnetized base element (base 1, Figure 1, wherein the base is magnetized by the forming of a magnetic film 3 onto the principal

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surface 1a, Col. 6, line 61-Col. 7, line 22), which has at least one receptacle (recessed portion 2, Figure 1) for a substrate (magnetic film 3).

Claim 13, Shouji et al. discloses the carrier device as recited in claim 12, wherein the substrate is a thin film substrate (thin magnetic film 3, shown in Figures 2-3).

Claim 14, Shouji et al. discloses the carrier device as recited in claim 12, wherein the base element includes a magnetized base metal sheet (once the magnetic film is formed on the base, as shown in Figure 3, the base includes the magnetized metal sheet represented by the metallic magnetic film 3, Col. 7, lines 9-22).

Claim 15, Shouji et al. discloses the carrier device as recited in claim 14, wherein the receptacle for the substrate is one of a drilled hole, a stamped hole, or a passage with or without depressions in the base metal sheet, a shape and dimensions of the receptacle being tailored to the contour of the substrate (forming of recessed portions 2 for magnetic film having the shape corresponding to the magnetic path shape of the magnetic core, Col. 7, line 61 – Col. 8, line 8).

Claim 16, Shouji et al. discloses the carrier device as recited in claim 15, wherein the base metal sheet has multiple at least one of: i) drilled holes, ii) stamped holes, and iii) passages with or without depressions, which are positioned in a grid (passages positioned in a grid such as those shown in Figure 3 or those shown in Figure 16).

Claim 17, Shouji et al. discloses the carrier device as recited in claim 12, wherein the substrate has a peripheral collar [outer edge's of the substrate, figure 4] and a shape and dimensions of the receptacle being such that the collar of the substrate rests only partially on the base element (as shown in Figure 3, when the substrate of

magnetic film 3 is within the receptacles 2, it rests only partially on the base element and not on the entire base element).

Claim 18, Shouji et al. discloses the carrier device as recited in claim 12, wherein the substrate has a collar [outer edge's of the substrate, figure 4], and a shape and dimension of the receptacle being such that the collar of the substrate rests only on an edge of the receptacle.

Claim 20, Shouji et al. discloses the carrier device as recited in claim 12, wherein the base element is at least partially made of a ferromagnetic material (complete base element shown in Figure 3 is partially made of ferromagnetic material 3).

Claim 21, Shouji et al. discloses the carrier device as recited in claim 12, further comprising at least one cover element configured to be situated on the base element from at least one of above and below, relative to the base element, the at least one cover being used during a processing of substrate (magnetic film 3 covers the base as shown in Figure 2 on the top surface 1a. The magnetic film covers the base during processing which results in the embodiment of Figure 3). It has been held that the recitation that the element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 1338.

Claim 22, Shouji et al. discloses the carrier device as recited in claim 21, wherein the at least one cover element is configured for a wet process, the at least one cover element having through openings or high media transparency (the sections where the magnetic film 3 does not cover the base 1 constitute through openings, Figure 3). It has

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been held that the recitation that the element is “configured for” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 1338.

Claim 23, Shouji et al. discloses the carrier device as recited in claim 21, wherein the at least one cover element (magnetic film 3 as shown in Figure 2) is configured for layer deposition (magnetic film 3 may comprise stacked insulating films, Col. 7, lines 19-22). It has been held that the recitation that the element is “configured for” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 1338.

Claim 24, Shouji et al. discloses the carrier device as recited in claim 21, wherein the at least one cover element (magnetic film 3 as shown in Figure 2) is configured for shadow mask deposition (mirror processing, Col. 7, lines 23-30). It has been held that the recitation that the element is “configured for” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 1338.

Claim 25, Shouji et al. discloses the carrier device as recited in claim 21, wherein the at least one cover element (magnetic film 3 as shown in Figure 2) is implemented in a form of sheets (stacked laminated insulating films, Col. 7, lines 19-22), each sheet being provided with at least one of: i) drilled holes, ii) stamped holes, and iii) passages with or without depressions (passages/depressions shown in Figures 1-3 for the forming of the magnetic film 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shouji et al. [US 5,796,564].

Shouji et al. discloses the claimed invention except for the composition of the base element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the composition of the base element to any magnetizable material, since applicant has not disclosed that using Sm<sub>4</sub>Co<sub>17</sub> solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the material disclosed by Shouji et al.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BERNARD ROJAS whose telephone number is (571)272-1998. The examiner can normally be reached on M and W-F, 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elvin G Enad/  
Supervisory Patent Examiner, Art Unit 2832

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/Bernard Rojas/  
Examiner, Art Unit 2832